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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
SHO-0049	

Application Number	Filed
10/697,246-Conf. #9027	October 31, 2003
First Named Inventor: Nobuyuki NONAKA	
Art Unit: 3714	Examiner: R. E. Pezzuto

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 29,211
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

Signature

Carl Schaukowitch
Typed or printed name

(202) 955-3750
Telephone number

October 5, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 form is submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Nobuyuki NONAKA
Application No.: 10/697,246
Filed: October 31, 2003
For: GAMING MACHINE

Attorney Docket No.: SHO-0049
Examiner: R. E. Pezzuto
Art Unit: 3714
Confirmation No.: 9027

ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner issued an Advisory Action dated September 19, 2007, in response to Applicant's Response to Final Office Action under 37 CFR 1.116 filed on August 6, 2007. Applicants' Response to Final Office Action was filed in response to the final Office Action dated June 8, 2007. A complete listing of the claims and the appropriate status identifiers can be found in Applicant's Response to Final Office Action on pages 2-4. No amendments were made to the claims in Applicants' Response to Final Office Action. The period for this response is extended to October 8, 2007, by the Petition for Extension of Time filed herewith.

In the final Office Action dated February 7, 2007, claims 1-9 are rejected under 35 USC 103 (a) as being unpatentable over Takemoto et al. (U.S. Patent No. 5,655,965). The rejection is respectfully traversed.

Takemoto teaches an interconnect device for electrically coupling a test instrument and a circuit board having a first portion of a ball grid array connector mounted thereon.

In rejecting claims under 35 U.S.C. 103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of

obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art."

Claim 1 is directed to a display device provided in a gaming machine. Claim 1 recites that a pitch P between pixel units, each of which is formed by arranging each kind of a plurality of kinds of pixel electrodes which display predetermined colors respectively, and a distance d from the display device to a player in a normal game posture satisfy a relationship of: $P < \tan(\pi/180/35) \times d$.

Claim 2 is directed to a display device provided in a gaming machine such as a slot machine or a pachinko machine. Claim 2 recites that a pitch P between pixel units, each of which is formed by arranging each kind of a plurality of kinds of pixel electrodes which display predetermined colors respectively, a distance d from the display device to a player in a normal game posture, and a correction value α satisfy a relationship of: $P = \tan(\pi/180/35) \times d/2 \times (1 + \alpha)$ where the correction value α is ± 0.2.

Claim 5 is directed to a gaming machine such as a slot machine or a pachinko machine that includes a display unit constituted by arranging in matrix a plurality of kinds of pixel electrodes that display predetermined colors respectively. Claim 5 recites that, in the display unit, a pitch P between pixel units, each of which is formed by arranging each kind of a plurality of kinds of pixel electrodes which display predetermined colors respectively, and a distance d from the display device to a player in a normal game posture satisfy a relationship of: $P < \tan(\pi/180/35) \times d$.

Claim 6 is directed to a gaming machine such as a slot machine or a pachinko machine that includes a display unit constituted by arranging in matrix a plurality of kinds of pixel electrodes that display predetermined colors respectively. Claim 6 recites that, in the display unit, a pitch P between pixel units, each of which is formed by arranging each kind of a plurality of kinds of pixel electrodes which display predetermined colors respectively, a distance d from the display device to a player in a normal game posture and a correction value α satisfy a relationship of: $P = \tan$

$(\pi/180/35) \times d/2 \times (1 + \alpha)$ where the correction value α is ± 0.2.

To cure the deficiencies in the art, the Examiner merely concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a distance "d" from the display device to a player in a normal game posture and a correction value "α" to satisfy a relationship of:

$$P = \tan (\pi/180/35) \times d/2 \times (1 + \alpha).$$

However, there is no teaching or suggestion in the applied art regarding the distance "d", a correction value "α" or the formula itself recited immediately above. Furthermore, this formula is recited only in independent claims 2 and 5. The United States Patent and Trademark Office completely ignores the formula, $P < \tan (\pi/180/35) \times d$, recited in independent claims 1 and 5. Thus, the United States Patent and Trademark Office fails to address the claimed features in independent claims 1 and 5.

It is respectfully submitted that one of ordinary skill in the art would not be motivated to modify the features of the invention in the applied art because the applied art invention is completely devoid of the features of the claimed invention. In fact, the applied art invention is completely devoid of the features recited in claims 1-9 of the claimed invention. Therefore, there is no reasonable justification for one of ordinary skill in the art to modify the features of the applied art.

Further, it is respectfully submitted that the screen display type slot machine with a seemingly flowing condition of moving symbols disclosed in the applied art is non analogous art. For instance, there is no teaching or suggestion in the applied art of "a pitch P between pixel units", "pixel electrodes" and "a player in a normal game posture" as recited in claims 1, 2, 5 and 6. As mentioned above, there is no teaching or suggestion in the applied art of "a correction value α" as recited in claims 2 and 6. Thus, it is respectfully submitted that a skilled artisan would not look to the applied art to find these features because these features are absent in the applied art and, thus, the applied art is non analogous.

Furthermore, it is respectfully submitted that the Examiner fails to consider all of the claimed features of the invention, especially those that are missing from the

prior art such as those mentioned immediately above. When evaluating a claim for determining obviousness, all limitations of the claim must be considered. The United States Patent and Trademark Office merely concludes that the claimed invention would have been obvious to one of ordinary skill in the art by modifying a generic slot machine with a LCD of Takemoto to arrive at the claimed invention.

In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988), the Federal Circuit held that a reference did not render the claimed combination *prima facie* because the Examiner ignored a material claimed temperature limitation which was absent from the reference. By analogy, the Examiner has ignored the material claimed features of the invention recited above in independent claims 1, 2, 5 and 6. The Federal Circuit in this case held want of *prima facie* obviousness in that "the mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that the requirement is in the reference.

It is respectfully submitted that nothing disclosed in the applied art teaches or even suggests that the applied art resolves the problems in the prior art discussed in the Applicant's specification. It is respectfully submitted that the United States Patent and Trademark Office ignores these advantages of the claimed invention.

Additionally, it is respectfully submitted that the motivation presented by the United States Patent and Trademark Office is derived from the claimed invention, not the applied art. Based upon the benefits of the claimed invention, the United States Patent and Trademark Office improperly establishes motivation because it is found in the claimed invention and not in the applied art. The United States Patent and Trademark Office must show motivation to modify the applied art in view of the applied art itself, not by showing the benefits of the claimed invention itself.

The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the reference to arrive at the claimed invention. The Examiner may not, because of doubt that the invention is patentable, resort to

speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. It is respectfully submitted that the Examiner's position is merely hindsight reconstruction and fails to provide any objective evidence whatsoever in the applied art to support his position.

It is respectfully submitted that the dependent claims are allowable at least for the reasons the independent claims are allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested.

Respectfully submitted,

Date: October 5, 2007 By: _____

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Enclosure(s): Notice of Appeal
Pre-Appeal Brief Request for Review
Petition for Extension of Time (one month)

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